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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,962	04/02/2004	Michael Joseph Armano	ARC920040004US1	2961

66932 7590 03/20/2009
IP AUTHORITY, LLC
RAMRAJ SOUNDARARAJAN
4821A Eisenhower Ave
Alexandria, VA 22304

EXAMINER

EVANS, KIMBERLY L

ART UNIT	PAPER NUMBER
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3629

NOTIFICATION DATE	DELIVERY MODE
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03/20/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ram@ip-authority.com
brandi@ip-authority.com

Office Action Summary	Application No. 10/708,962	Applicant(s) ARMANO ET AL.	
	Examiner KIMBERLY EVANS	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/05; 4/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed April 2, 2004..
2. Claims 1 and 16 have been amended; claims 2-14 and 17-40 have been cancelled.
3. Claims 1 and 16 are currently pending and have been examined.

Information Disclosure Statement

4. Information Disclosure statements filed April 7, 2005 and April 8, 2005 have been considered and are initialed.

Claim Rejections - 35 USC § 101

5. The following is a quotation of the first paragraph of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 1 and 16 are rejected under 35 U.S.C. 101 because the claimed component is interpreted as being software per se; software does not fall within a statutory category of patentability.
7. Claims 1 and 16 are rejected under 35 USC 101 because the method disclosed is directed toward non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. A mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. The machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means, reciting a specific machine or a particular transformation of a specific article in an insignificant step such as data gathering or outputting, is not sufficient to pass the test. If neither of these requirements is met by the

claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Double Patenting

8. Claim 1, limitations a-f of this application conflicts with claim 1, limitations a-f of Application No 12/130379. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the

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- reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
11. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
12. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1 of copending Application No. 12/130379. Although the conflicting claims are not identical, they are not patentably distinct from each other because the both disclose a business practice alignment method to apply business practices or cultures within the business unit.
13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

15. Claims 1 and 16 are rejected under 35 U.S.C. 102(a) as being anticipated by Trompenaars et al., Culture for Business Series: Business Across Cultures, Capstone Publishing Ltd., 2/2/04, pp 30-32, 114,144,148,303-305, herein referred to as “Trompenaars”.
16. With respect to Claim 1,
- Trompenaars discloses the following limitations,
- *a. eliciting at least one of: intent and goals from each of said participating entity or entities in said synchronization;* (see at least pg. 30: “...seven dimensional model is a means to elicit, describe, and frame the major dilemmas organizations must resolve...”)
 - *b. developing detailed alternatives statements in support of said elicited intent and goals;*(see at least page 144: “...we need to develop solid products vs. services we need to be driven by the needs of the clients...”)
 - *c. selecting from said alternatives statements, pairs of alternatives statements that are in tension with each other;*(page 144: “...looking at the tensions developed through the core values of both organizations we had captured at least five of the key strategic dilemmas the organization as a whole was facing....”)
 - *d. reconciling said pairs of alternatives statements; e. establishing a charter of practices by integrating a set of said reconciled pairs of alternatives statements;* (see at least page 144: “...we discussed the main tensions between both organizations.....our dilemma reconciliation methodology resulting in the following set of integrated values...”)
 - *f. synchronizing at least one of said business practices and culture of said participating entity or entities in view of said practices charter* (see at least page 114)

- *wherein said practices charter reflects strategic, operational and tactical alternatives of how said entity or entities are to be operated and how work is to be performed within said entity or entities, and a conveyance of said reconciled pairs of alternatives statements to realistic work conditions is made such that it is clear to people performing the work, how work is to be conducted, (see at least page 32: "...when faced with cultural differences, one effective approach is to compare the two profiles based on the linear seven dimensions model to identify where the major differences originate...by reconciling the dilemmas deriving from the differences on the orientations, organizations can begin to reconcile their cultural orientations...)*
- *said reconciled pairs of alternatives statements are applied to realistic work conditions to produce a series of outcome narratives each of which comprises:*
- *(1) either of: a situation or dilemma statement; (2) a desired outcome in which answers are given to a list of questions about actions to be taken, roles of decision makers, and behaviors associated with those who need to take action; (see at least page 304: "...we follow a series of methodological steps in achieving this that make use of worksheet tools and grids...")*
- *(3) a list of in-scope roles, an in-scope role being performed by one or more individuals involved in an action according to said desired outcome; (4) role behaviors and actions associated with in-scope roles, wherein role behaviors and actions specify the desired way the desired outcome is to be accomplished; and (see at least page 144: "...conceptualize a renewed mission statement and set of core values...)*
- *(5) other applicable considerations that specify additional information that could be important in translating the details of the outcome narrative to other issues that have similar characteristics.(see at least page 114, Figure 4.2: Flow of cultural change process)*

17. With respect to Claim 16,

Trompenaars discloses all of the above limitations, Trompenaars further discloses,

- *a. listing issues that might arise within the regular work of said entity or entities, an issue being a work requirement, occurrence, or choice that requires action by one or more people and that could be disputed by those required to take action or responsible for an outcome, and for which one or more reconciled statements will apply; (see at least table on page 148: "...On the one hand: 4. We need to be innovative in our product choice vs we need to be consistent in our image...")*
- *b. classifying issues as situations and dilemmas, a situation being an issue with a relatively small number of roles or a generally agreed upon preferable outcome and a dilemma being an issue with a relatively large number of roles or general disagreement on preferable outcome; and (see at least pg. 32: "...those dilemmas you face when working with other people)*
- *c. writing a statement to represent each classified situation and dilemma, each statement being a brief, realistic, fictional narrative instantiation with adequate detail for decision, adequacy being determined by comparison to a given set of standard examples.(see at least page 144: ...On the one hand 4. We need to work in teams...our next step in supporting this client was to conceptualize a renewed mission statement and set of core values...")*

Conclusion

18. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.

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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/Kimberly Evans/Examiner, Art Unit 3629

/JOHN G WEISS/

Supervisory Patent Examiner, Art Unit 3629